



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/608,617	06/30/2000	Scott D Smyers	SONY-12100	9459

28960 7590 11/02/2006
HAVERSTOCK & OWENS LLP
162 NORTH WOLFE ROAD
SUNNYVALE, CA 94086

EXAMINER

FILIPCZYK, MARCIN R

ART UNIT PAPER NUMBER

2163

DATE MAILED: 11/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/608,617

Applicant(s)

SMYERS ET AL.

Examiner

Marc R. Filipczyk

Art Unit

2163

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) 16-18 and 36-43 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15, 19-35 and 44-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This Action is responsive to Applicant's Appeal Brief filed July 27, 2006 in which claims 1-15, 19-35 and 44-54 are pending. Examiner withdraws the Final Rejection submitted on April 14, 2006 because new deficiencies were found and further upon updating search, Examiner found new pertinent prior art, therefore a new non-final Action is submitted herein on the merits.

In view of the Appeal Brief filed on July 27, 2006, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

To expedite the process of examination Examiner requests that all future correspondences in regard to overcoming prior art rejections or other issues (e.g. amendments, 35 U.S.C. 112, objections and the like) set forth by the Examiner that Applicants provide and link to the most specific page and line numbers of the disclosure where the best support is found (see 35 U.S.C. 132).

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 19-23 and 53 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth whether the invention accomplishes a practical application and whether it generates a useful, concrete and tangible result.

The guidelines explain that a practical application of a 35 U.S.C. 101 judicial exception is claimed if the claimed invention physically transforms an article or physical object to a different state or thing, or if the claimed invention otherwise produces a useful, concrete, and tangible result.

In the present case, independent claims 19 and 53 do not involve transformation of article or physical object to a different state or thing, they merely recite a meta data header. Further, independent claims 19 and 53 do not produce a useful, concrete, and tangible result, but merely disclose a meta data header without generating a useful, concrete and tangible result. State Street, 149 F.3d at 1373-74, 47 USPQ2d at 1601-02.

Claims 19 and 53 taken as a whole are directed to a mere method claim, i.e., to only its description or expression, is an abstract idea and does not comprise a practical application as explained above hence are nonstatutory.

Since the claimed invention, as a whole, does not comprise a practical application as explained above, claims 20-23 which depend from claim 19 respectively, are deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Art Unit: 2163

Claim 2 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding the segment “the header” is indefinite. It is not clear what header is referred to.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-15, 19-35 and 44-54 are rejected under 35 U.S.C. 102(e) as being anticipated by Webb (U.S. Patent No. 6,675,177).

Regarding claim 1, Webb discloses a method and system of writing data to a media storage device comprising: (abstract and figs. 1-3)

receiving a received packet of data to be written to the media storage device, the received packet of data including a packet header; (figs. 1-3, col. 7, lines 7-9 and related text)

adding a metadata header to the received packet of data thereby forming an extended packet of data including both the packet header and the meta data header (figs. 3 and 7-9, item 10, col. 6, lines 27-30, *merge* and col. 7, lines 9-26), wherein the packet is an isochronous packet of data (abstract);

Art Unit: 2163

(Note: IEEE 1394-1995 is an international standard for implementing isochronous and asynchronous format data transfers in a network, see Background of Invention of the Instant Application)

storing the extended packet of data onto a media within the media storage device (figs. 3 and 7-9, item 10, col. 6, lines 27-30, *merge* and col. 7, lines 9-26).

Regarding claim 2, Webb discloses a cycle control to locate cycle boundaries and controlling number of a cycle in which the received packet of data was received (col. 3, lines 9-13 and col. 4, lines 1-8).

Regarding claim 3, Webb discloses received packet of data is an isochronous packet of data received over isochronous channels (figs. 1-3, network).

Regarding claims 4 and 5, Webb discloses adding a header to the received packet of data is performed by an embedded stream processor within a storage device (figs. 1-3, server/cache/tape, also see *additional meta data* on fig. 9).

Regarding claim 6, Webb discloses the network complies with IEEE 1394 standard (see abstract, and figs. 1-3, *network* and col. 15, lines 55-58).

Regarding claim 7, hard disk is inherent from a storage device.

Art Unit: 2163

Regarding claims 8-15, 19-35 and 44-54 contain the same subject matter as claims 1-7 and therefore are rejected on the same ground. In addition, regarding Isochronous Headers refer to fig. 9, *Additional Meta Data* and figs. 1-3, and regarding deleting or flushing headers and data refer to col. 7, lines 16-26 of Webb.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following prior art, Traw et al shows in accordance with Applicant's background disclosure that IEEE 1394-1995 is an international standard for transferring asynchronous and isochronous data transfers, in addition, Traw et al teaches cycle control, isochronous channels, packet transmitter/receiver and arbitration.

U.S. Patent No. 6,012,117 of Traw et al.

This Action in Non-Final.

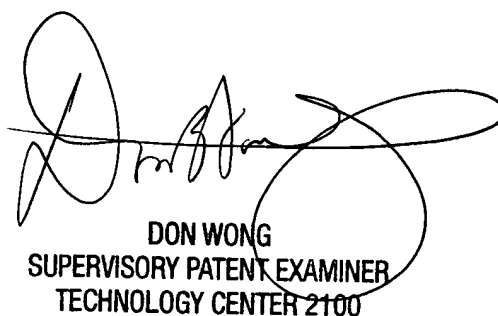
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marc R. Filipczyk whose telephone number is (571) 272-4019. The examiner can normally be reached on Mon-Fri, 8:30am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2163

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MF
October 27, 2006



DON WONG
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100